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--141. A method of executing play lists based on a media inventory comprising:

providing an inventory of at least audibly presentable media items;
presenting visually at least a part of a pre-established play list based on some of the media items simultaneously while presenting visually, at least in part, a list of media items from the inventory;

editing the play list by selecting at least one media item from the inventory list and inserting it into the play list at a selected location within the list thereby forming a revised play list; and

executing a selected play list and accumulating item popularity information.

REMARKS

Reexamination and reconsideration of the above-identified application are hereby requested. Applicants have given very careful consideration to the Examiner's rejections in the Office Action and associated supporting comments.

By this Amendment, a number of the claims have been rewritten in independent form. These include claims 68, 70, 71, and 75 which the Examiner in the prior Office Action had objected to as containing allowable subject matter but being dependent on a rejected base claim. A number of additional allowable claims have also been added. Finally, filed concurrently herewith is an additional Supplemental Information Disclosure Statement with a number of patents which have recently come to the attention of applicants. Consideration and entry of the additionally submitted patents into the record of this application are respectfully requested.

As explained below, the pending claims are all allowable over the prior art of record.

An apparatus which embodies the present invention incorporates, in one aspect, a play list editor which enables a user to view both part of a media inventory list and part of a play list of interest simultaneously on the same display. The editor enables the user to select an entry from the media inventory list and insert the selected entry into the selected display play list to create a modified play list which can then be saved. Another pre-stored

play list can then be displayed, on the same display as the inventory is listed and subsequently be edited by the user.

In another aspect, an apparatus which embodies the invention provides for downloading of works, via a communication link, from a remote source, and played or presented to a user. The works can include both audible and visible works. In yet another aspect, only the works which are unavailable locally need be downloaded.

In yet a further aspect, an apparatus which embodies the present invention can keep track of billing information. For example, the number of plays of a given work can be accumulated and transmitted, via communication link, to a remote processor for the purpose of generating billing information or lists. Alternately, each time a work is downloaded from a displaced source for presentation to a user, billing information can be accumulated at the downloading source for subsequent use.

In these various embodiments, the user has an ability to modify, edit, one or more play lists prior to execution. The user thus controls the contents of a play list of interest.

Unlike the claimed apparatus, Bernard et al is an automated product purchasing system. Bernard et al provides an inventory from which a plurality of items can be selected, and placed into a shopping cart for purchase. The purpose and intent of the system of Bernard et al is to enable a user to select and place items into a shopping cart. The selected items are subsequently delivered to the user via a delivery service to a shipping address. (Col. 3, ll. 63-67).

Where the selected product items are music or video products, the system of Bernard et al provides a browsing function:

“where the product is music, the customer can browse through the available selections based on the artist’s name and the titles of the albums available by that artist. This form of browsing is best suited to a customer who knows which particular products he or she is most interested in purchasing ... For example, when the customer accesses the automated purchasing system, he or she may be provided with the option of hearing the top hits in his or her area, the tracks featured in a local radio station’s play list, a featured artist, and the like ... Where the product is movies, a similar scenario can be used whereby the customer can sample movies based on top box office hits, top sales, award-winning titles, films featuring certain stars, and other similar criteria. This facilitates browsing among the various selections offered.” (Col. 4, ll. 26-64).

As is apparent from the above, Bernard et al merely make certain works available in user selected categories or in play lists created by third parties or associated with featured artists or the like. The nature of the play lists in Bernard et al is such that they have a purpose, "tracks featured in a local radio station's play list" (col. 4, ll. 46, 47). These lists are beyond the control of the purchasers. This browsing process is quite unlike the claimed invention.

The Examiner recognized the deficiencies in Bernard et al and combined therewith Mimick et al and Goldman in support of the outstanding obviousness rejections. We first note that there is no teaching or suggestion in any of these documents cited by the Examiner which would direct one of skill in the art to combine them as proposed by the Examiner other than the roadmap provided by the present application. This is clearly an improper form of hindsight reconstruction which cannot properly be used to establish a prima facie case of obviousness.

Mimick et al teaches a system which revolves around track numbers and index values associated with track numbers. (See step 422 and 424 of Fig. 4 thereof). This process is described in col. 8, l. 5- col. 9, l. 4 thereof. This form of editing enables a user to "establish a programmed queue" (col. 2, ll. 32-33) and is quite unlike the process and apparatus of the claimed invention.

Beyond the above differences, the purpose of the system of Bernard et al, a product purchasing system, is quite different from the purpose of Mimick et al which is a system which provides for programming or editing the order of performance of digitally recorded information blocks. The former deals with a process where items can be acquired and delivered. Additionally, Bernard et al makes it possible for a user to sample audio works listed on a third party's play list which is not created or modified by the purchaser. On the other hand, Mimick et al is directed to creating a list of digitally recorded items to be presented in a sequence to a user where the user has possession and ownership of the source of the work. The track sequence editor of Mimick et al would not be incorporated by one of skill into the system of Bernard et al because the purpose of the system of Bernard et al, the selection and delivery of items to a purchaser, is quite different from and would have no need for an editor of the type disclosed in Mimick et al.

Additionally, as noted above, the system of Bernard et al enables a purchaser to hear selections off of a third party's play list. Bernard et al have no need for permitting a purchaser to modify that list as such modification would defeat its purpose. Hence, one of skill in the art would not import the editing system of either Mimick et al or Goldman into the system of Bernard et al given the differences in purposes between those disclosed systems. The only motivation or suggestion for the combination proposed by the Examiner, as noted above, comes from the present application. A proper prima facie case of obviousness cannot be made out based on such hindsight reconstruction.

Submitted concurrently herewith is an additional Supplemental Information Disclosure Statement which is requested be incorporated into the prosecution record of the present application. For all of the above reasons, it is believed that the pending application is in condition for allowance, and such allowance is respectfully requested.

Respectfully submitted,

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